

REMARKS

Summary

Claims 17-28 were pending; Claims 21, 22, 25 and 28 were withdrawn; and Claims 17-20, 23, 24, 26 and 28 were rejected in the present Office Action. The Specification has been amended to clarify the description of the shapes of the depressions. Claim 17 has been amended. No new matter has been added.

Objections

The specification was objected to as not describing the shapes of the depressions in Fig. 1 and 2 as being ellipsoidal. As the drawing represents a general non-spherical concave surface, it may be described as ellipsoidal, paraboloidal or the like. The drawing makes clear that the surface is not spherical, as the point where the tangent to the surface is parallel to the base of the substrate is not equidistant from all points on the periphery of the intersection of the surface with the upper surface of the substrate. This is supported in the specification at page 18, lines 1-2, where the concave surface is in a "spoon-like non-spherical shape". However, the Applicants also note the contradiction with the description found at page 17, last line, of the specification, where the intersection of the concave surface with the surface of the substrate is termed "circular", and has further amended the specification to replace the word "circular" with "curvilinear", which is a more appropriate description of the shape.

Claim Rejections

Double Patenting

A double patenting rejection was made of Claims 1 and 8 of the present application in view of Claims 17 and 26 of US Patent 6,750,930. However, this application does not contain claims 1 and 8, nor does the cited patent include claims 17 and 26. The Applicants cannot identify the claims meant by the Examiner and is unable to make a proper response. In the event that the Examiner intends to maintain a double patenting rejection in the next Office

Action, the Applicants respectfully submit that it should be a non-final action in order to permit a response.

In the event that the Examiner inadvertently interchanged the claim numbers of the present application with that of the patent which issued from the parent application, the Applicants respectfully note that, prior to this amendment, the present Claim 17 had been presented as Claim 18 of patent application serial 09/896,165, which issued as US Patent 6,750,930, of which the present application is a properly filed divisional application. Claim 18 was included in species C, which was restricted by the Examiner in the Office Action of June 18, 2003. When a claim has been restricted by the Examiner and the applicants choose to pursue the claimed subject matter in a divisional application, the claim in the divisional application is not subject to the judicial doctrine of double patenting. This situation also pertains to Claim 26.

35 U.S.C. § 102 (b)

Claims 17-20 and 26-27 were rejected under 35 U.S.C. § 102 (b) as being anticipated by Sasaki et al. (US 6,130,736; "Sasaki"). Claim 17 has been amended to more fully describe the subject matter.

Amended Claim 17 recites, *inter alia*, a plurality of curved portions, said portions being formed with a random separation with respect to each other on a surface of the base material.

Sasaki teaches, with respect to Fig. 5 thereof, that the surfaces shown as elements 26 and 27 are stripe grooves in the vertical and lateral directions and arranged to cross each other. (Id. col. 13, line 67- col. 14 line 11). Thus the concave surfaces formed are preferentially disposed along each of the axes of the grooves, and are not disposed with random separation with respect to each other. Therefore, Sasaki does not teach all of the elements and the arrangement thereof of amended Claim 17, and the claim is not anticipated.

Claims 18-20 and 23-27 are claims dependent on an allowable independent claim and are allowable, without more.

35 U.S.C. § 103 (a)

Claims 23 and 24 were rejected under 35 U.S.C. § 103 (a) as being unpatentable over Sasaki in view of Akins et al. (US 6,285,425). The Applicants respectfully traverse this rejection as a *prima facie* case of obviousness has not been made out.

The Applicants respectfully submit that Examiner has improperly used hindsight to read the teachings of the present Claims 23 and 24 into the references. "Obviousness may not be established using hindsight or in view of the teachings or suggestions of the inventor." *Para-Ordnance Mfg. v. SGS Importers Int'l*, 73 F.3d 1085, 1087, 37 USPQ2d 1237, 1239 (Fed. Cir. 1995) (citing *W.L. Gore & Assocs., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1551, 1553, 220 USPQ 303, 311, 312-13 (Fed. Cir. 1983)). "The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the [specific] modification." No such showing has been made in the Office action and therefore Claims 23 and 24 are allowable.

Notwithstanding this traverse, the Applicants also maintain that Claims 23 and 24 are allowable, without more, as claims dependent on an allowable claim.

Rejoinder of Withdrawn Claims

Claims 21, 22, 25 and 28 had been withdrawn by the Examiner in accordance with election of species requirements. As Claim 17 is allowable, and the dependent claims are in proper form and dependent thereon, the Applicants respectfully request that the withdrawn claims be rejoined and allowed.

Conclusion

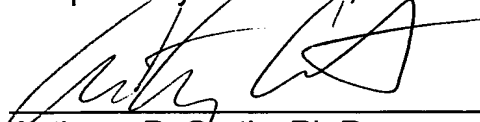
Claims 17-20 and 26-27 are pending. Claim 17 has been amended.

Applicants respectfully submit that all of the pending claims are in condition for allowance and seek an early allowance thereof.

Serial No.: 10/668,878

The Examiner is respectfully requested to contact the undersigned in the event that a telephone interview would expedite consideration of the application.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Anthony P. Curtis', is written over a horizontal line.

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